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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/447,490 11/23/99 ECKARDT

R 0691-018A/GP

EXAMINER

HM12/0301
SCHWEITZER CORNMAN GROSS & BONDELL LLP
230 PARK AVENUE
SUITE 2200
NEW YORK NY 10169

MCKENZIE, T	
ART. UNIT	PAPER NUMBER

1611
DATE MAILED: 03/01/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/447,490

Applicant(s)

ECKARDT ET AL.

Examiner

Thomas McKenzie Ph. D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 1999.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
- ☐ received.
 - ☐ received in Application No. (Series Code / Serial Number) _____.
 - ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other:

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DETAILED ACTION

1. This action is in response to amendment filed 2/7/00. Attorney's letter of 2/7/00 is noted. Claims 2-8 are pending in the application. A corrected PTO-892 form is presented to cite properly the Board of Patent Appeals and Interferences decision previously cited.

Specification

2. The disclosure is objected to because of the following informalities: page 2 line 15 and page 3 line 3, "hydrogen cyanide" is used when cyanic acid is meant. Applicants' amendment of 11/23/99 changed cyanhydroxide to the improper hydrogen cyanide. The objection to "sucked-off" is withdrawn.

Response to Amendment

3. The amendment filed 2/7/00 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the aqueous alcohol choice, as part of the acidic medium, is not itself described in the specification or any of the working examples. As stated previously on page 4, there is no mention of the use of aqueous alcohol as a concept although the individual components are

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mentioned. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Claims 5-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The aqueous alcohol choice, as part of the acidic medium, is not itself described in the specification or any of the working examples. There is no mention of the use of aqueous alcohol as a concept although the individual components are mentioned. The amendment to the specification is deemed new matter (see paragraph 3) and hence can not be relied upon.

5. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word "optionally" is not automatically indefinite but here its role is not known since it introduces a further member of a Markush group and thus has no role.

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6. Claims 2-5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated or, in the alternative, under 35 U.S.C. 103(a) as obvious by Acklin (EP 277,095) with evidence supplemented by Patterson's "German-English Dictionary for Chemists". The Acklin reference has important differences between the EP 277,095 and the US counterpart 4,847,374 as set forth previously. The claims are not rejected over the US equivalent but rather relying on material present in the EP but not the US Patent. Claim 14 of Acklin (EP 277,095) teaches that the disclosed process is not limited to the preferred acidic agents i.e. formic acid or stronger. Hence, all elements of applicants' process are present, including use of acetic acid as the sole acidic agent.

7. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acklin (EP 277,095). The second and third paragraphs of page 4 of the English translation of Acklin (EP 277,095) describe production of the required HNCO by treatment of an alkali cyanate with an acid and that acetic acid is a suitable solvent for the reaction with iminostilbene. Working examples 9 and 10 spanning pages 13 and 14 of the translation teach reaction of iminostilbene with HNCO in acetic acid with no additional acids present. This would render obvious preparing the HNCO *in situ*. Claims 5 and 6 of Acklin teach releasing and using

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HNCO from alkali cyanates without isolating the HNCO. Dependant claim 7 of Acklin teaches doing the release of HNCO in acetic acid. Examiner's statement that "Acklin .. also teaches .. acetic acid as the sole acidic agent" is a direct quote from Acklin (EP 277,095) thus not "entirely conjectural". This material is not in the US Patent nor part of the original translation so not considered by the Board of Patent Appeals and Interferences.

8. Claim 6 is rejected as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim. Acklin does not teach adding water to the reaction mixture.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

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of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

10. Direct any inquiry concerning this communication or earlier communications from the examiner to Thomas C. McKenzie, Ph. D. whose telephone number is (703) 308-9806. The examiner can normally be reached on 8:30 to 5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on (703) 308-4716. The fax number for the organization where this application or proceeding is assigned is (703) 308-4556 for regular communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

TCMcK *TCM*
February 16, 2000

Mark Beer
...CH
PRIMARY EXAMINER
GROUP 120 - ART UNIT 1600